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Attorney Docket No. CA920000046US1 (7161-287U)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Customer Number: 46320
Hendra SUWANDA, et al. : Confirmation Number: 7250
Application No.: 09/998,347 : Group Art Unit: 3691
Filed: November 30, 2001 : Examiner: B. Shrestha
For: CONTRACT-BASED ELECTRONIC CATALOGS

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed September 12, 2007, and in response to the Examiner reopening prosecution in the Office Action dated May 28, 2008, wherein Appellants appeal from the Examiner's rejection of claims 11-17 and 20.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on December 10, 2001, at Reel 012345, Frame 0807.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

1 **III. STATUS OF CLAIMS**

2 Claims 11-17 and 20 are pending and two-times rejected in this Application. Claims 1-
3 10 and 18-19 have been cancelled. It is from the multiple rejections of claims 11-17 and 20 that
4 this Appeal is taken.

5 **IV. STATUS OF AMENDMENTS**

6 An Amendment, accompanying this Appeal Brief, was submitted to cancel claims 1-10.
7 Since the Amendment would reduce the number of issues on Appeal,¹ Appellants proceed on the
8 basis that the Amendment will be entered.

9 **V. SUMMARY OF CLAIMED SUBJECT MATTER**

10 Referring to Figures 1 and 2 and also to independent claim 11, a method is disclosed.
11 The method defines and displays a set of electronic catalogs 32, 34 for a defined product
12 universe. Each of the catalogs in the set have an associated contract (page 6, lines 20-23). Each
13 of the users of the electronic each are associated with one of the contracts (page 6, lines 23-25).
14 Each catalog has a unique catalog identifier (page 6, lines 10-12, 19), and each contract has a
15 unique contract identifier (page 6, line 18). A graph (page 6, lines 20-21) representing the
16 electronic catalogs is generated, stored, and maintained. Each node in the graph contains data,
17 and each edge in the graph connects two nodes and is associated with one or more catalog or
18 contract identifiers (page 6, line 28 through page 7, line 1). The graph is traversed in response to
19 user requests, and the traversal of the graph is constrained by the catalog or contract identifiers

¹ See M.P.E.P. § 706.07(e) ("An amendment that will place the application ... in better form for appeal may be admitted.").

- 1 associated with the edges in the graph (page 8, lines 9-10). The data at the reached nodes in the
- 2 traversal of the graph is displayed to the user (page 8, lines 10-13).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 11-14 were rejected under 35 U.S.C. § 101;
2. Claims 15-20 were rejected under the second paragraph of 35 U.S.C. § 112; and
3. Claims 11-17 and 20 were rejected under 35 U.S.C. § 102 for anticipation based upon Hare et al., U.S. Patent No. 6,850,900 (hereinafter Hare).

VII. ARGUMENT

1 Prior to addressing the individual rejections, Appellants note that in reopening
2 prosecution in the Third Office Action, the Examiner added new rejections based upon 35 U.S.C.
3 § 101, 112. However, the rejection of claims 11-17 and 20 under 35 U.S.C. § 102 for
4 anticipation based upon Hare remains the same from the Examiner's Second Office Action.
5 Despite the extensive arguments presented in the First Appeal Brief dated February 7, 2008
6 (hereinafter First Appeal Brief), the Examiner did not even attempt to address these arguments
7 despite M.P.E.P. § 707.07(f), entitled "Answer All Material Traversed," which clearly states that
8 upon Applicants traversing the Examiner's rejection, "the examiner should, if he or she repeats
9 the rejection, take note of the applicant's argument and answer the substance of it."

10
11 Appellants presume that the Examiner's failure to respond to Appellants' arguments in the
12 First Appeal Brief was intentional and for the purpose of introducing new rejections without
13 having to subject the Examiner's analysis regarding the rejection of claims 11-17 and 20 under
14 35 U.S.C. § 102 to scrutiny twice more (i.e., after the present Third Office Action reopening
15 prosecution and after the Examiner's Answer). Instead, by ignoring Appellants' arguments in the
16 First Appeal Brief, the Examiner's response will only be scrutinized after the Examiner has
17 prepared the Examiner's Answer. Thus, the Examiner has deprived both Appellants and the
18 Honorable Board with the opportunity to have the number of issues narrowed prior to Appeal.
19 Since Appellants do not have an Examiner's "Response to Remarks" section to respond to,
20 Appellants can only repeat the arguments previously presented in the First Appeal Brief and
21 address the newly presented rejections.

THE REJECTION OF CLAIMS 11-14 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, claims 12-14 stand or fall together with independent claim 11.

On page 4 of the Third Office Action, with regard to the newly presented rejection under 35 U.S.C. § 101, the Examiner asserted the following: "[c]laims 11-14 recite a process comprising the steps of investing, selecting, and arranging." However, none of claims 11-14 includes steps of investing, selecting, and arranging. As such, Appellants are unclear as to whether or not the Examiner actually intended to reject the claims based upon 35 U.S.C. § 101 or whether this rejection was an artifact from a "copy and paste operation" that the Examiner used to create the present rejection.

Notwithstanding the Examiner's failure to make any findings of fact with regard to the actual claims at issue and the issue of 35 U.S.C. § 101, Appellants respectfully submit that the generic issue raised by the Examiner does not apply to the present claims. Specifically, the Examiner asserted the following:

To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus (e.g. computer) that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

At the outset, Appellants note that the Examiner has failed to produce any case law that stands for the proposition that "the claim should positively recite the other statutory class to which it is tied."

1 In discussing Arrhythmia Research Tech. v. Corazonix Corp., 958 F.2d 1053, 22
2 USPQ2d 1033 (Fed. Cir. 1992), the Federal Circuit in AT&T Corp. v. Excel Commc'ns, Inc.,
3 172 F.3d 1352 (Fed. Cir. 1999), held that "the claimed process 'transformed' data from one 'form'
4 to another simply confirmed that Arrhythmia's method claims satisfied 101 because the
5 mathematical algorithm included within the process was applied to produce a number which had
6 specific meaning." Thus, the "transformation or reduction" is not limited to "physical subject
7 matter." Instead, the transformation can be directed to a product, such as a data structure. By
8 creating a graph representing electronic catalogs, the claimed invention transforms data
9 regarding electronic catalogs into a different data structure (i.e., the graph). Thus, the claimed
10 invention is directed to a transformation of a statutory class of subject matter.

11
12 **THE REJECTION OF CLAIMS 15-20 UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112**

13 For convenience of the Honorable Board in addressing the rejections, claims 16-20 stand
14 or fall together with independent claim 15.

15
16 On page 5 of the Third Office Action, the Examiner asserted the following regarding the
17 newly presented rejection under the second paragraph of 35 U.S.C. § 112:

18 Claims 15-20 are not sufficiently precise due to the combining of two separate statutory classes
19 (method and computer program product) of invention in a single claim. The independent claim 11
20 recites as computer readable medium but the dependent claims 15-20 recites computer program
21 product.
22

23 Appellants respectfully submit that the Examiner has failed to establish a prima facie case
24 of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the
25 following:

1 If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C.
2 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why
3 the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action.
4 (emphasis added).
5

6 As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,² "[o]nly when a claim
7 remains insolubly ambiguous without a discernible meaning after all reasonable attempts at
8 construction must a court declare it indefinite." The Examiner, however, has failed to
9 established the aforementioned findings.
10

11 The Examiner's assertion that the claims are "not sufficiently precise due to the combining
12 of two separate statutory classes" evidences a complete unawareness by the Examiner as to one
13 manner in which claims are drafted. Specifically, the reference of one claim (e.g., a method) to a
14 structure recited in another claim is extremely common. For example, claim 1 could recite a
15 machine tool, and claim 2 could recite a method of using the machine tool recited in claim 1.
16 Appellants are entirely unclear why the Examiner believes one having ordinary skill in the art
17 would consider such a language to not be sufficient precise.
18

19 Appellants' position is that one having ordinary skill in the art would have no difficulty
20 understanding the scope of claims 15-20, particularly when reasonably interpreted in light of the
21 written description of the specification.³ Therefore, for the reasons stated above, Appellants
22 respectfully submit that the imposed rejection of claims 15-20 under the second paragraph of 35
23 U.S.C. § 112 is not viable.
24

² 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

³ In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

THE REJECTION OF CLAIMS 1-17 AND 20 UNDER 35 U.S.C. § 102 FOR ANTICIPATION

BASED UPON HARE

For convenience of the Honorable Board in addressing the rejections, claims 14-17 and 20 stand or fall together with independent claim 11; dependent claim 2 stands or falls alone; and dependent claim 3 stands or falls alone.

As is evident from Appellants' previously-presented comments during prosecution of the present Application and from Appellants' comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's Answer.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single

reference.⁴ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁵ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁶ This burden has not been met.

Appellants' Prior Arguments regarding claim 11

On pages 11-13 of the First Response dated May 29, 2007 (hereinafter the First Response), Appellants presented the following arguments. To teach the claimed "means for generating, storing and maintaining a graph representing the electronic catalogs," the Examiner cited Fig. 5, Figs. 7A-C, and column 16, lines 16-28 of Hare. However, upon reviewing these figures and the Examiner's cited passage, Appellants have been unable to find this teaching. For ease of reference, column 16, lines 16-28 is reproduced below:

The content management application 18 also provides a plurality of interfaces which enable the supplier's contract manager to create general catalogs for buyers and specifically general catalogs for contracts with specific buyers. The system provides: (a) a general catalog-select items interface as illustrated in FIG. 7A which enables the supplier contract manager to select items for inclusion in the general catalog; (b) a general catalog-select items interface as illustrated in FIG. 7B which enables the supplier to include the selected items in the general catalog; and (c) a general catalog-naming interface as illustrated in FIG. 7C which enables the supplier to name the general catalog.

⁴ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁵ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁶ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 This passage fails to teach the claimed limitations as to several aspects. The claims recite
2 "a graph" (i.e., a single graph as subsequent limitations refer to the graph) being used to represent
3 "the electronic catalogs" (i.e., a plurality of catalogs). However, what is described by Hare refers
4 to a single catalog (i.e., the "general catalog"). Moreover, the claims recite "a graph representing
5 the electronic catalogs." What is illustrated in Figs. 7A-7C is not a graph. Furthermore, the
6 claim recites "storing and maintaining a graph," yet Figs. 7A-7C are described as "general
7 catalog creation interfaces." As is common in the art, the interfaces are recreated each time they
8 are generated and not stored and maintained, as claimed. Thus, the Examiner has failed to
9 establish that Hare identically discloses these further limitations.

10
11 To teach the claimed "each node in the graph containing data," the Examiner cited Figs.
12 11A-Q, Figs. 12A-J, and Figs. 15A-G. However, upon reviewing these figures, Appellants note
13 that these figures describe several different interfaces. Thus, not only are these interfaces not
14 graphs, as claimed, these interfaces are not a single graph, as claimed. Thus, the Examiner has
15 failed to establish that Hare identically discloses these further limitations.

16
17 To teach the claimed "each edge in the graph connecting two nodes and being associated
18 with one or more catalog or contract identifiers," the Examiner cited Figs. 11J, 11L, Fig. 12C,
19 Fig. 12D, and Fig. 12E. Appellants are entirely unclear why the Examiner is citing these figures.
20 These figures illustrate interfaces, not a graph, as claimed.

21
22 To teach the claimed "means for traversing the graph in response to user requests, the
23 traversal of the graph being constrained by the catalog or contract identifiers associated with the

edges in the graph," the Examiner cited Fig. 1 and columns 16-35 of Hare. It is readily apparent that the Examiner has no idea where Hare teaches this limitation, since the Examiner cited 20 columns of text for a limitation that is only 30 words long. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The manner in which the Examiner conveyed the statement of the rejection, which is to cite 20 columns of text, has not "designated as nearly as practicable" the particular parts in Hare being relied upon in the rejection.

Examiner's Response

On page 13 of the Second Office Action, the Examiner responded to Appellants' prior arguments as follows:

The Applicant further argues that claim recited "a graph" to represent "electronic catalogs" rather than a single catalog referred by Hare et al. and reference Fig. 7A-C is not a graph. As per reference of **dictionary.com**, graph has been defined as "a diagram representing a system of connections or interrelations among two or more things by a number of distinctive dots, lines, bars, etc". As can be seen from Fig. 7A-C, these display could be represented in graphical form by connecting by lines; these Figures shows interrelationship among two or more things, for example catalogue TPN (16378) and abrasives, batteries and bearings etc. Similarly, Fig. 11 J and 11L were cited to show how contract 0020 (edge) contains contract catalogs (nodes) gc-sabs-0600, cabinet, ms-cabinets and scott.

The issue of claim construction is discussed in M.P.E.P. § 2111, entitled "Claim Construction; Broadest Reasonable Interpretation," a portion of which is reproduced below:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) ... The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

1 The Examiner's "interpretation," however, is both unreasonable and not consistent with
2 Appellants' specification. A saying, heard occasionally in patent circles, is "just because you
3 could put your shoe on your head doesn't make it a hat." Similarly, just because "these display
4 could be represented in graphical form by connecting by lines," as asserted by the Examiner,
5 does not make the interfaces within Hare a graph corresponding to that claimed. Moreover, as
6 noted above, anticipation requires identical disclosure, which is different that "what if"
7 disclosure (i.e., what if these displays were represented in graphical form?). As an aside,
8 Appellants also note that being "graphical" does not necessarily equate to be a "graph."

9
10 Claim 12

11 The Examiner's cited passages fails to identically disclose contract nodes, catalog nodes,
12 category nodes, product nodes and price nodes in the graph (i.e., a single graph). Instead, the
13 Examiner cites to at least 5 different user interfaces, and not a graph, as claimed.

14
15 Claim 13

16 The Examiner's cited passages fails to identically disclose an edges notwithstanding that
17 particular edges are associated with contract and catalog identifiers.

18
19 Conclusion

20 Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections
21 under 35 U.S.C. §§ 101-102 and 112 is not viable. Appellants, therefore, respectfully solicit the
22 Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101-102 and 112.

Application No.: 09/998,347

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 9, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

11. A method for defining and displaying a set of electronic catalogs for a defined product universe, each of the catalogs in the set having an associated contract, users of the electronic catalogs each being associated with one of the contracts, each catalog having a unique catalog identifier and each contract having a unique contract identifier, the method comprising the following steps:

generating, storing and maintaining a graph representing the electronic catalogs,

each node in the graph containing data and

each edge in the graph connecting two nodes and being associated with one or more catalog or contract identifiers,

traversing the graph in response to user requests, the traversal of the graph being constrained by the catalog or contract identifiers associated with the edges in the graph, and displaying to the user the data at reached nodes in the graph traversal.

12. The method of claim 11 in which the nodes comprise contract nodes, catalog nodes, category nodes, product nodes and price nodes, in which

child nodes for a contract node comprise catalog nodes,

a catalog node may have alternatively, child category nodes or child product nodes,

child nodes for category nodes comprise product nodes,

child nodes for product nodes comprise price nodes, and

in which each parent node has a potential plurality of child nodes.

13. (Currently Amended) The method of claim 12 in which

each edge between a contract node and a catalog node is associated with a contract identifier,

each edge between a catalog node and a category node is associated with a catalog identifier,

each edge between a category node and a product node is associated with a catalog identifier and

each edge between a product node and a price node is associated with a contract identifier.

14. The method of claim 13 in which the step of traversing the graph comprises the step of comparing the contract identifier for the contract with which a user is associated or the catalog identifier for the catalog with which the user's contract is associated and the identifier associated with a reached edge in the graph and further comprises the step of traversing that reached edge only when the comparison shows a match condition.

15. A computer program product for defining and displaying a set of electronic catalogs, the computer program product comprising a computer usable medium having computer readable code means embodied in said medium, comprising computer readable program code means for carrying out the method of claims 11, 12, 13, or 14.

16. The computer program product of claim 15 wherein said computer readable code means comprises a computer readable signal and said medium comprises a computer readable signal-bearing medium.

17. The program product of claim 16 wherein said medium is a recordable data storage medium.

20. A computer program comprising computer program code means adapted to perform all the steps of claims 11, 12, 13, or 14 when said program is run on a computer system.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.